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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/592,017

09/07/2006

Armin Kuebelbeck

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EXAMINER

PARVINI, PEGAH

ART UNIT

PAPER NUMBER

1793

NOTIFICATION DATE

DELIVERY MODE

10/01/2009

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

docketing@mwzb.com

<b>Advisory Action</b> <b>Before the Filing of an Appeal Brief</b>	Application No. 10/592,017	Applicant(s) KUEBELBECK, ARMIN	
	Examiner PEGAH PARVINI	Art Unit 1793	

**--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

THE REPLY FILED 17 September 2009 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 6 months from the mailing date of the final rejection.  
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on \_\_\_\_\_. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

#### AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because  
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);  
(b) ☐ They raise the issue of new matter (see NOTE below);  
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or  
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: \_\_\_\_\_. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).  
5. ☒ Applicant's reply has overcome the following rejection(s): Trau et al. in view of Su and Unger et al. in view of Su.  
6. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).  
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.  
The status of the claim(s) is (or will be) as follows:  
Claim(s) allowed: \_\_\_\_\_.  
Claim(s) objected to: \_\_\_\_\_.  
Claim(s) rejected: 1,2 and 6-28.  
Claim(s) withdrawn from consideration: \_\_\_\_\_.

#### AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).  
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).  
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

#### REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:  
See Continuation Sheet.  
12. ☐ Note the attached Information *Disclosure Statement*(s). (PTO/SB/08) Paper No(s). \_\_\_\_\_  
13. ☐ Other: \_\_\_\_\_.

/J.A. LORENZO/  
Supervisory Patent Examiner, Art Unit 1793

Continuation of 11. does NOT place the application in condition for allowance because: Applicants have argued that Blizzard et al. is not directed to the production of polysilicic acid (i.e. silica) particles by hydrolysis polycondensation.

The Examiner, respectfully, submits that Blizzard et al. is used in a 103(a) obviousness rejection over a combination of references, namely Teller et al. in view of Blizzard et al., and that Blizzard et al., as clearly shown, was used for their teaching on the use of ethanolamine in a very similar process. Additionally, as pointed out, Blizzard et al. even though may not expressly disclose the production of polysilicic acid (i.e. silica) particles, clearly discloses hydrolysis and polycondensation of tetraalkoxysilane being initiated in the presence of water in an environment where there exists ethanolamine base. It is to be noted that Teller et al. disclose a very similar process in which there exists ammonia base. Thus, Blizzard et al. was used to address the use of the base of ethanolamine in a very similar process as that taught by Teller et al.

Furthermore, in response to Applicants' argument that Blizzard et al. is not directed to the production of polysilicic acid (i.e. silica) particles and thus can't be used as a prior art, it should be noted that one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Furthermore, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992).

Finally, it is to be noted that the same response is valid for arguments drawn to Blizzard et al. in the rejection of Trau et al. in view of Blizzard et al. and Unger et al. in view of Blizzard et al.

Applicants have argued that Blizzard et al. do not employ pentaerythritol tetra-acrylate as a solubilizer.

It is to be noted that while the reference teaches the same compound as Applicants consider to be the solubilizer and impart the solubilizing effect, the compound is expected to impart the same effect and have the same properties.

Finally, it is to be noted that the same response is valid for arguments drawn to Blizzard et al. in the rejection of Trau et al. in view of Blizzard et al.

Applicants have argued that nothing within the rejection indicates that either Teller et al. or Blizzard et al. teach that ammonia and ethanolamine are functionally equivalent.

It is noted that based on the disclosure of Teller et al. and Blizzard et al., each alone, ethanolamine and ammonia each is used in a hydrolysis-polycondensation of alkoxysilane in the presence of water and a base; the base is ethanolamine in one reference and ammonia in the other; thus, ethanolamine and ammonia impart similar effects and properties. Therefore, they are taken to be functionally equivalent.

Again, it is noted that contrary to Applicants' indication that Blizzard et al. do not teach a similar process as of Teller et al., it should be noted that just because Blizzard et al. do not expressly teach the production of mono-dispersed polysilicic acid particles, does not mean that the process of said reference is different than that of Teller et al. specially considering the fact that Blizzard et al. was used as a secondary reference and was not relied upon to teach the production of silica particles. In fact, such teaching has been provided in Teller et al. as detailed out in the previous Office action.

With reference to Applicants' argument drawn to the production of mono-dispersed particles upon using ethanolamine, it is to be noted that as shown by Table 1, which Applicants have also pointed to in their remarks, mono dispersed particles have also been obtained upon using ammonia.

With reference to Applicants' argument regarding the porosity of the particles, it is to be noted that Teller et al. in view of Blizzard et al. meet the limitation of instant claims while Teller et al., in fact, meet the limitations of a number of dependent claims as well and Blizzard et al. teaches a very similar process of hydrolysis polycondensation of tetraalkoxysilane in the presence of water and ethanolamine which is a very similar process as that taught by Teller et al. with the difference of using ammonia as the base instead of ethanolamine. Thus, it is expected that the particles be porous especially in view of the fact that the reference does not disclose it otherwise.

Applicant have argued that Anselmann et al. do not disclose a process wherein hydrolytic polycondensation of tetraalkoxysilane is performed in a medium comprising water, one or more solubilizers and an amine, namely ethanolamine.

The Examiner, respectfully, submits that as shown in the previous Office action, Anselmann et al. was used for their teaching on controlling the particle size of silica using metering the addition of tetraalkoxysilane or corresponding silane, specially considering the fact that the combination of Teller et al. in view of Blizzard et al., specially Teller et al., disclose simultaneous or step-wise addition of precursor materials such as tetraalkoxysilane and terminal silane fluorescent dye in hydrolysis medium of alcohol and a base such as ammonia and water. It should be noted that one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Finally, it is to be noted that the same response is valid for arguments drawn to Anselmann et al. in the rejections of Trau et al. in view of Blizzard et al. and Unger et al. in view of Blizzard et al.

Applicants have argued that nothing within the rejection indicates that either Trau et al. or Blizzard et al. teach that ammonia and ethanolamine are functionally equivalent.

It is noted that based on the disclosure of Teller et al. and Blizzard et al., each alone, ethanolamine and ammonia each is used in a hydrolysis of alkoxysilane in the presence of water and a base; the base is ethanolamine in one reference and ammonia in the other; thus, ethanolamine and ammonia impart similar effects and properties. Therefore, they are taken to be functionally equivalent.

Applicants' argument drawn to Trau et al. in view of Su, considering the amendment made to the claims, is persuasive. Therefore, said rejection is hereby withdrawn.

Applicants' argument drawn to Unger et al. in view of Su in view of the amendment made to the claims is persuasive. Therefore, said rejection is hereby withdrawn. .